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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/606,745

06/27/2003

Peter Gluckman

704652-9001

5345

7590 04/04/2007
BINGHAM McCUTCHEN, LLP
Three Embarcadero Center
San Francisco, CA 94111-4067

EXAMINER

RUSSEL, JEFFREY E

ART UNIT	PAPER NUMBER
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1654

MAIL DATE	DELIVERY MODE
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04/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/606,745

Applicant(s)

GLUCKMAN ET AL.

Examiner

Jeffrey E. Russel

Art Unit

1654

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 28 February 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. ~~See attached Notice of Non-Compliant Amendment (PTOL 324).~~
5. ☒ Applicant's reply has overcome the following rejection(s): See attachment.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 16-26, 28-38, 64 and 65.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

1. The proposed amendments to the title, specification, and claims filed February 28, 2007 will not be entered because their amendment format does not comply with 37 CFR 1.173(b) and (d). In particular, the changes to the title of the invention are not shown using underlining and bracketing. The proposed amendment to the specification uses strikethrough rather than brackets to indicate deleted subject matter. At line 5 of the proposed amendment to the specification, a semicolon has been inserted without being marked by underlining. Claims 16 and 18, which are new claims with respect to the patent undergoing reissue, should be entirely underlined. Claims 64-77 use a status identifier, “(Added)”, which is not authorized by 37 CFR 1.173(b)(2). See also section 1 of the final Office action mailed August 29, 2006 for a discussion of proper amendment format.

2. The proposed amendment to the specification filed February 28, 2007 will not be entered because it indicates that US Patent Application Serial No. 08/460,365 claims priority to International Patent Application PCT/US92/06389 under 35 U.S.C. 371, 120, and 119. The claims for priority to the International Patent Application ‘389 under 35 U.S.C. 120 and 119 are improper because a claim for priority under 35 U.S.C. 371 and claims for priority under 35 U.S.C. 119 and 120 are mutually exclusive. US Patent Application Serial No. 08/460,365 was originally filed under 35 U.S.C. 371 based upon the International Patent Application ‘389, and therefore subsequent claims for priority based upon 35 U.S.C. 120 and 119 are not permitted. See, e.g., MPEP 1893.03(c) at page 1800-199, paragraph bridging columns 1 and 2 (Rev. 5, Aug. 2006).

3. Proposed new claims 68-71 and 74-77 contained in the amendment filed February 28, 2007 raise new issues requiring further consideration and/or search, especially with respect to the

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obviousness rejections set forth in the final Office action. Treatment of these particular injuries has not previously claimed.

4. The objection for lack of consent of the assignee to the reissue, set forth in section 3 of the final Office action, is maintained for the reasons of record. The new forms discussed by Applicants have not been received by the time it became necessary to prepare this Office action.

5. As noted in the Examiner Interview Summary Record dated November 2, 2006, this application now satisfies the requirements for a claim for priority under 35 U.S.C. 119(a)-(d) based upon NZ 239211 (see section 5 of the final Office action); and the rejection under 35 U.S.C. 251 set forth in section 6 of the final Office action has been overcome. Any further substantive amendment to the specification and/or claims will result in a requirement for a supplemental reissue oath or declaration, in accordance with 37 CFR 1.175(b).

6. The proposed amendment to the specification, if it had been entered, would have overcome the objection set forth in section 7 of the final Office action, and would have overcome the rejections set forth in sections 8 and 9 of the final Office action.

7. In view of the declaration under 37 CFR 1.132 by Bonni filed February 28, 2007, the rejection under 35 U.S.C. 112, second paragraph, set forth in section 10 of the final Office action is withdrawn with respect to finally rejected claims 16, 20-22, 24-26, 28, 32-34, and 36-38. The rejection is maintained with respect to claims 17-19, 23, 29-31, and 35, because the declaration does not address the apparent inconsistency between the specific CNS injuries recited in these claims and the claim requirement that the injury affects predominantly glia cells.

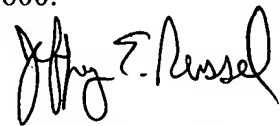
8. The rejections set forth in sections 12 and 13 of the final Office action are maintained for the reasons of record. With respect to the first of these two rejections, Applicants cite to

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paragraph 26 of the Decision on Motions. However, it should be noted that this paragraph states that "treatment" is not targeted to a specific cell type - all disclosed methods of administration will result in the active agents contacting both neuronal and glia cells. This paragraph of the Decision on Motions does not address whether "injuries" which predominantly affect glia cells are disclosed in the applications involved in the interference. Obviously such injuries are disclosed, at least in the application which issued as U.S. Patent No. 5,714,460, for which reissue is now being sought. An example of such a disclosed injury is multiple sclerosis, which is claimed by the '460 patent, and which claims were designated as corresponding to the count in the interference. With respect to the second of these two rejections, Applicants have not provided any explanation as to why claims which embrace or are drawn to the treatment of glial cells injured by multiple sclerosis, are not estopped when analogous claims were designated as corresponding to the count.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:00 A.M. to 5:30 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Cecilia Tsang can be reached at (571) 272-0562. The fax number for formal communications to be entered into the record is (571) 273-8300; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.



Jeffrey E. Russel
Primary Patent Examiner
Art Unit 1654

JRussel
March 29, 2007